

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SCHLAGE LOCK COMPANY,

Opposer,

Opposition No. 91 159885
Serial No. 76/493,797

v.

ALTO PRODUCTS CORP.,

TTAB

Applicant.

OPPOSER'S RESPONSE TO
APPLICANT'S MOTION TO COMPEL

INTRODUCTION

Opposer submits that Applicant's Motion to Compel should be denied. Not only is Applicant's motion premature because Opposer already produced confidential documents to Applicant less than two weeks following the Board's entry of the Protective Order, but it was also filed without adequate effort on the part of Applicant, by conference or correspondence, to resolve with Opposer the issues presented in Applicant's motion pursuant to 37 C.F.R. 2.120(e). Applicant sent a letter to Opposer the day the stipulated protective order was entered by the Board demanding that Opposer produce its confidential documents "immediately," and filed this motion without any further effort to resolve the issues. Opposer respectfully submits that Applicant's demand was unreasonable and its lack of effort to work with Opposer to resolve their differences equally unreasonable.

Applicant's motion is also hypocritical as Applicant has failed to produce its own confidential documents following entry of the Protective Order. Applicant responded to nearly every single interrogatory and document request that Opposer served on it by saying that a response would be given and documents would be produced only after entry of a Protective

10-21-2004

Order (this despite the fact that many of the requests called for production of publicly disseminated documents like advertising materials and product packaging). Yet Applicant has failed to supplement its discovery responses and document production following entry of the Protective Order by the Board. Indeed, Applicant has thus far produced only 15 documents in contrast to the over 6500 documents that have now been produced by Opposer. It is completely unreasonable for Applicant to hold Opposer to a higher standard than it has applied to itself.

FACTS

On July 15, 2004, Opposer sent additional documents to Applicant marked Bates Nos. KRY-004528 through KRY-006445 via Federal Express. See Exhibit A. The next day, Opposer received a letter from Applicant by facsimile indicating that Applicant had not received any documents responsive to various requests. See Exhibit B. With respect to almost every request identified in that July 16, 2004 letter, Opposer had raised various objections, including an objection that the request sought confidential information of Opposer, and that responsive documents would be produced pursuant to the entry of an acceptable Protective Order by the Board. Applicant's July 16, 2004 letter did not acknowledge or address any of Opposer's objections made in its discovery responses.

Applicant sent a letter to Opposer on September 2, 2004, which essentially is a duplicate of Applicant's July 16, 2004 letter. See Exhibit C. Opposer promptly responded to Applicant's letter the same day, and indicated that it would produce its confidential documents upon entry of the Protective Order by the Board. See Exhibit D.

On September 9, 2004, the Board's approval and entry of the stipulated Protective Order was noted on TTABVUE. Applicant sent a letter to Opposer that same day demanding that Opposer "immediately" send confidential documents to Applicant. See Exhibit E. Applicant

filed its Motion to Compel days later. The day that Opposer received Applicant's Motion was the same day that Opposer sent confidential documents to Applicant via Federal Express, along with a letter substantively responding to Applicant's July 16, 2004 letter that relates to specific responses and objections to Applicant's discovery requests. See Exhibit F.

ARGUMENT

As a result of Opposer's September 22, 2004 production, the bulk of Applicant's Motion is moot. If Applicant had simply telephoned Opposer prior to filing its motion to find out if documents were on the way, it could have saved the Board considerable time and effort rather than jumping the gun and filing the present motion. Applicant's motion is particularly disingenuous given its own utter failure to comply with its obligations to respond adequately and fully to Opposer's discovery requests, an issue which is addressed in more detail in Opposer's motion to compel filed on even date herewith.

Applicant appears to be most concerned with receiving documents responsive to Applicant's First Document Request Nos. 63 to 66:

Request 63: All agreements with DC Comics.

Request 64: All agreements referred to in DC Comics v. Kryptonite Corporation

Request 65: All litigation and other papers and things referred to in DC Comics v. Kryptonite Corporation.

Request 66: All papers in all disputes with DC Comics, and its predecessors.

Opposer's Response to Request Nos. 63 and 64 stated that it would produce documents pursuant to the entry of a Protective Order. See Exhibit G. With respect to Request Nos. 65 and 66, Opposer objected on the basis that each request is "vague, overbroad and incomprehensible." See *Id.* Applicant has yet to address Opposer's objections substantively.

Opposer has been involved with litigation with DC Comics for several years now. As stated in Opposer's letter dated September 22, 2004, "there are literally tens of thousands of documents relating to the *DC Comics v. Kryptonite Corporation* case. If Applicant sufficiently narrows its requests, Opposer will consider production of documents responsive to such a request." Again, Applicant has yet to narrow its requests, and until it does so, Opposer maintains its objections. Those document requests seek "all litigation and papers and other things referred to" in the D.C. Comics case, whatever that means. What does it mean to ask for "all litigation?" Or "all papers and other things referred to" in a piece of litigation? Or "all papers in all disputes with D.C. Comics?" These phrases simply do not make sense. Even if one were generous and interpreted these requests as seeking all documents relating to the D.C. Comics litigation, the requests would encompass tens of thousands of pieces of paper.

Furthermore, Applicant's motion fails to substantively address the objections raised by Opposer in response to the various discovery requests set forth in the motion. Applicant has also failed to give these objections adequate consideration in written or verbal correspondence with Opposer prior to the filing of this motion. Accordingly, Opposer maintains that Applicant's efforts to resolve its discovery disputes are far from adequate; Applicant's objections are meritorious; and Opposer's motion should be denied.

CONCLUSION


Opposer respectfully submits that Applicant's motion should be denied as failing to meet the requirements of 37 C.F.R. 2.120(e) and as moot and on the basis that Opposer's objections to

Applicant's discovery requests are proper such that Applicant is not required to further respond to the subject requests.

Dated: October 12, 2004

Respectfully submitted,

MICHAEL BEST & FRIEDRICH LLP

By: 
Dyann L. Kostello
Lori S. Meddings
100 East Wisconsin Avenue, Suite 3300
Milwaukee, WI 53202

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Opposer's Response to Applicant's Motion to Compel has been served on Applicant by fax and sending the same via first-class regular United States mail to Applicant's attorney:

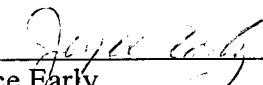
Stephen Feldman
Stephen E. Feldman, P.C.
12 East 41st Street
New York, NY 10017

Fax: 212 532 8598

on the 12 day of October, 2004.

and that the original of said document was filed on the same day with the TTAB by sending the same (plus two copies) via First Class Mail, postage prepaid, as addressed to:

Trademark Trial and Appeal Board
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513



Joyce Early

Michael Best & Friedrich LLP
100 East Wisconsin Avenue, Suite 3300
Milwaukee, WI 53202
Telephone: (414) 271-6560
Facsimile: (414) 277-0656

X:\clientb\056227\9085\A0964925.1

Two Riverwood Place
N19 W24133 Riverwood Drive
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Author: Lori S. Meddings
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150 Independent Firms

July 15, 2004

Via Federal Express

Stephen E. Feldman, Esq.
12 East 41st Street
New York, NY 10017

Re: Schlage Lock Company v. ALTO Products Corp.
Opposition No. 91 159885
File No. 056227/9085

Dear Mr. Feldman:

Enclosed are Opposer's Responses to Applicant's Third Request for Production or Documents.

We have also enclosed additional documents for production, Bates Nos. KRY-004528 through KRY-006445.

Very truly yours,

MICHAEL BEST & FRIEDRICH LLP

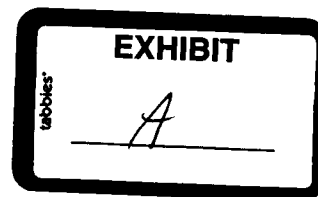

Lori S. Meddings

LSM/jle

Enclosure (1 box)

cc: (w/o Enc.) Dyann L. Kostello, Esq.
Judith L. Grubner, Esq.

X:\clientb\056227\9085\A0873173.1



Law Offices of
STEPHEN E. FELDMAN, P.C.

12 EAST 41st STREET
NEW YORK, NEW YORK 10017
TELEPHONE: (212) 532-8585
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sfeldman@feldman-law.com

LONG ISLAND OFFICE
120 MAIN STREET (ROUTE 25A)
HUNTINGTON, NEW YORK 11743
PATENT AND TRADEMARK LAW

July 16, 2004

VIA FAX

Dyann L. Kostello
Michael Best & Friedrich, LLP
101 East Wisconsin Avenue, Suite 3300
Milwaukee, Wisconsin 53202

Re: Schlage Lock Company v. ALTO Products
Corp.
Opposition No.: 91159885

Dear Ms. Kostello:

We recently received your document production and Opposer's Responses to Applicant's First and Second Request for Production of Documents. We find your responses inadequate and your production incomplete. Specifically, Applicant did not receive any documents covering the following:

- A. The annual unit and dollar volume of sales of goods sold under Opposer's Mark. (See App. First Doc. Request Nos. 15 and 16).
- B. The annual expenditures incurred for advertising and promotion of goods sold under Opposer's Mark. (See App. First Doc. Request Nos. 17 and 18).
- C. Any agreements between Opposer and any retailers or wholesalers which sell Opposer's goods under Opposer's Mark. (See App. First Doc. Request Nos. 21 to 28).
- D. An organizational chart of Opposer. (See App. First Doc. Request No. 30).
- E. Documents sufficient to identify Opposer's subsidiaries and affiliates. (See App. First Doc. Request No. 31).
- F. Any Market Research performed by Opposer for goods sold under Opposer's Mark. (See App. First Doc. Request Nos. 34, 35 and 49).



- G. Opposer's trademark enforcement policies. (See App. First Doc. Request No. 51).
- H. All agreements and litigation papers in connection with *DC Comics v. Kryptonite Corp.*, No. 00 Civ. 5562 AGS. (See App. First Doc. Request Nos. 63 to 65).

If we do not receive the above documents, we will be forced to file a motion with the TTBA requiring Opposer to so.

Additionally, Applicant in its Second Document Request asked Opposer to provide documentation regarding:

- A. All documents showing the manufacture and sale of automobile products to automobile mechanics. (See App. Second Doc. Request Nos. 2 to 3). and
- B. All documents showing the sale and marketing of products to the automotive repair field. (See App. Second Doc. Request Nos. 5 to 7).

Opposer responded with multiple objections and did not produce the requested papers. Applicant believes these documents go to the heart of the case (i.e., whether or not Opposer has a market for automotive repair parts under the Kryptonite Mark.) and should be produced.

It is noted that Opposer has produced a small amount of advertisements containing an automotive security lock. (See, e.g., KRY 646-647, 661-664, 752-753, and 2580-2582). These documents, however, are not related to the automotive repair field. We, therefore, ask Opposer to reconsider its objections and either produce the above-requested papers or admit that these documents do not exist because Opposer has no plans to enter the automotive repair field.

Very truly yours,

Stephen E. Feldman

SEF/MTD

cc: Alto

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LONG ISLAND OFFICE
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HUNTINGTON, NEW YORK 11743
PATENT AND TRADEMARK LAW

September 2, 2004

VIA FIRST CLASS MAIL

Lori Meddings
Michael Best & Friedrich, LLP
101 East Wisconsin Avenue, Suite 3300
Milwaukee, Wisconsin 53202

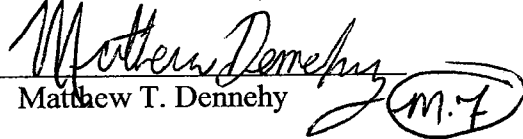
Re: Schlage Lock Company v. ALTO Products
Corp.
Opposition No.: 91159885

Dear Ms. Meddings:

Enclosed are documents responsive to Opposer's First Request for Production of Documents.
(Alto 0001 - Alto 0015).

Sincerely,

STEPHEN E. FELDMAN, P.C.

By: Matthew T. Dennehy
Matthew T. Dennehy 



Two Riverwood Place
N19 W24133 Riverwood Drive
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150 Independent Firms

September 2, 2004

VIA FACSIMILE 212-532-8598 and U.S. MAIL

Stephen E. Feldman, Esq.
12 East 41st Street
New York, NY 10017

Re: Schlage Lock Company v. ALTO Products Corp.
Opposition No. 91 159885
File No. 056227/9085

Dear Mr. Feldman:

We just received your letter of September 2, 2004. As stated in our letter sent earlier today, while Opposer has produced over 4,500 documents thus far in this proceeding, Applicant has not produced a single document. In addition, while Applicant has addressed some of the concerns raised in our July 29, 2004 letter relating to the deficiencies in Applicant's responses to Opposer's discovery requests, we still await a response with respect to Applicant's improper objections to Opposer's Requests for Production of Documents and Things. As stated in our earlier letter, if a prompt response is not received, we will be the ones filing a motion to compel.

Further, the Protective Order in this case was just filed this week, and as stated in Opposer's responses to Applicant's document requests, any confidential documents will only be produced once a Protective Order has been entered by the Board. All of the document requests identified in your letter today relate to confidential documents, which is why Applicant has not been given copies of these documents.

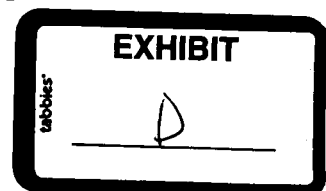
Applicant has already received copies of all non-privileged documents responsive to its discovery other than those deemed confidential. Again, any confidential documents will only be produced after the Protective Order has been approved and entered by the Board.

Very truly yours,

MICHAEL BEST & FRIEDRICH LLP


Lori S. Meddings

cc: Dyann L. Kostello, Esq.



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Michael, Best & Friedrich LLP
RECEIVED

SEP 09 2004

September 9, 2004

DOCKETING
MILWAUKEE, WI

VIA Facsimile

✓ Lori Meddings
Michael Best & Friedrich, LLP
101 East Wisconsin Avenue, Suite 3300
Milwaukee, Wisconsin 53202

Re: Schlage Lock Company v.
Alto Products Corp.
Opposition No.: 91159885

Dear Ms. Meddings:

This letter is to inform you that the TTBA has entered our Protective Order. We, therefore, expect production of all documents referred to in our July 16th and September 2nd letters. If the requested documents are not received immediately, we will be forced to file a motion compelling production.

Very truly yours,



Matthew T. Dennehy
Stephen E. Feldman

Attachment

56-21-9085-0
JSD

LONG ISLAND OFFICE
120 MAIN STREET (ROUTE 25A)
HUNTINGTON, NEW YORK 11743
PATENT AND TRADEMARK LAW



September 22, 2004

Via Federal Express

Stephen E. Feldman, Esq.
12 East 41st Street
New York, NY 10017

Re: Schlage Lock Company v. ALTO Products Corp.
Opposition No. 91 159885
File No. 056227/9085

Dear Mr. Feldman:

Enclosed are Opposer's Confidential documents along with a number of additional non-confidential documents for production, Bates Nos. KRY-006446 through KRY-006525.

In response to Applicant's July 16, 2004 letter:

- A. Opposer has produced documents herewith relating to sales in response to App. First Doc. Request Nos. 15 and 16.
- B. Opposer has produced documents herewith relating to advertising expenditures in response to App. First Doc. Request Nos. 17 and 18.
- C. Opposer has no agreements with retailers or wholesalers in its possession or control responsive to App. First Doc. Request Nos. 21 to 28.
- D. Opposer is still gathering documents responsive to App. First Doc. Request No. 30.
- E. Documents responsive to Request No. 31 are produced herewith.
- F. Opposer has no documents concerning market research responsive to App. First Doc. Request Nos. 34, 35 and 49.
- G. Opposer has no documents pertaining to internal trademark enforcement policies responsive to App. First Doc. Request No. 51.

EXHIBIT

F

Stephen E. Feldman, Esq.
September 22, 2004
Page 2

- H. Opposer maintains its objections with respect to App. First Doc. Request Nos. 63 to 65. There are literally tens of thousands of documents relating to the *DC Comics v. Kryptonite Corp.*, case. If Applicant sufficiently narrows its requests, Opposer will consider production of documents responsive to such a request.
- I. Opposer has produced documents in its earlier production responsive to App. Second Doc. Request Nos. 2 to 3.
- J. Opposer has produced documents in its earlier production responsive to App. Second Doc. Request Nos. 5 to 7.

We await production of Applicant's confidential documents.

Very truly yours,

MICHAEL BEST & FRIEDRICH LLP


Lori S. Meddings

LSM/jle

Enclosures

cc: (w/o Enc.) Dyann L. Kostello, Esq.

RESPONSE NO. 59

Opposer objects to this Request as overbroad, unduly burdensome, indefinite and as seeking attorney-client privilege and work product information and material. Subject to, and without waiving these objections, Opposer will produce non-privileged documents responsive to this request.

Request No. 60:

With respect to each expert that Opposer expects to call as a witness in this proceeding, a report containing the information specified in Rule 26(a)(2)(B) of the Federal Rules of Civil Procedure.

RESPONSE NO. 60

Opposer has not identified an expert in this case.

Request No. 61:

All documents identified in response to Applicant's First Set of Interrogatories to Opposer.

RESPONSE NO. 61

Documents responsive to this Request will be produced.

Request No. 62:

A privilege log identifying, for each Applicants' First Date of Interrogatories to Opposer and for each request herein, each document, communication or thing that contains any information responsive to such interrogatories or requests and that is being withheld because of a claim of privilege, immunity, or other protection, and stating, for each such document, communication or thing, the basis for withholding it, its date and nature, the parties transmitting and receiving it, and its subject matter.

RESPONSE NO. 62

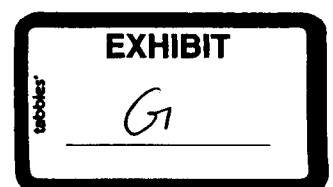
A privilege log will be produced.

Request No. 63:

All agreements with DC Comics.

RESPONSE NO. 63

Opposer objects to this Request as seeking confidential proprietary business information. Subject to, and without waiving these objections, Opposer will produce documents responsive to



this Request pursuant to the entry of an acceptable Protective Order by the Board.

Request No. 64:

All agreements referred to in DC Comics v. Kryptonite Corporation.

RESPONSE NO. 64

Opposer objects to this Request as seeking confidential proprietary business information. Subject to, and without waiving these objections, Opposer will produce documents responsive to this Request pursuant to the entry of an acceptable Protective Order by the Board.

Request No. 65:

All litigation and other papers and things referred to in DC Comics v. Kryptonite Corporation.

RESPONSE NO. 65

Opposer objects to this Request as vague, overbroad and incomprehensible.

Request No. 66:

All papers in all disputes with DC Comics, and its predecessors.

RESPONSE NO. 66

Opposer objects to this Request as vague, overbroad and incomprehensible.

Request No. 67:

All the files of the following Oppositions/cancellation proceedings 91153668, 76377515, 76377514, 91152807, 78039703, 91123908, 91122454, 91123452 and 91111872.


RESPONSE NO. 67

Opposer objects to this Request as seeking information in the public record, which is readily available to Applicant.

Dated: May 18, 2004

Respectfully submitted,

MICHAEL BEST & FRIEDRICH, LLP

By: 
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